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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,508	11/28/2000	Teresa F. Lunt	104135	5996

7590 01/24/2006
Oliff & Berridge, PLC
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EXAMINER

ARANI, TAGHI T

ART UNIT PAPER NUMBER

2131

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/722,508	Applicant(s) LUNT ET AL.	
	Examiner Taghi T. Arani	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-17 have been examined and are pending

Response to Arguments

2. Applicant's arguments filed 11/21/2005 have been fully considered but they are not persuasive.

Applicant has argued that "Stefik fails to disclose a document forgery protection printing method, comprising (in part) a computerized policy stored on a computer device" and that "Stefik discloses that the owner writes the digital work and assigns the usage rights including a print right, which specifies watermark information (Fig. 5, Step 501). Therefore, it is the owner of the digital work that determines and enters the forgery protection requirement for the document as part of the usage writes language. Thus, there is no computerized policy stored on the computer device that determines the forgery protection requirements for the document to be printed as disclosed in the present invention."

The Examiner disagrees for the following reasons.

The applicant's own specification, page 4, 1st paragraph, states "The policy 113 determines the required protection level for the document 140 to be printed by collecting information about the value of the document 140 from the document creator or owner or from any other person authorized to print the document 140. The information may include assumptions about potential forgery and the cost necessary to provide a level of protection to detect and/or deter the potential forgery. The user may enter the information about the document 140 through a graphical user interface provided on one of the display units 151-153 of the particular computers 121-123 being used to print the document 140", emphasis added.

Furthermore , Stefik et al. disclose a digital rights management system enforcing protection level on a digital work (col. 3, lines 22-36, presented in the Office action mailed 6/21/2005). Specifically Stefik et al explicitly teaches "[T]he present invention extends the existing capabilities of the system for controlling distribution and use of digital works to provide a measure of protection when a document is printed. The present invention adds to the system the ability to include watermark information to a document when it is rendered (i.e. a Print right associated with the document is exercised)" and that (col. 17, line 14 through col. 18, line 5) "the server stores the encrypted document, step 1705. At some point, the spooler gets ready to print the document. Before starting, it runs a process to create a new version of the glyph font that encodes the watermark data, step 1706. It looks up the required watermark information in its own certificates as well as certificates from the repository and user. Finally, the spooler begins imaging the document, one page at a time, step 1707. The above cited portions of Stefik reference teaches "a print management system and a computerized policy" claimed in the pending Application.

The Examiner is attempting to clarify the teachings of the prior art reference and how it reads on the claims. In order for the applicant to have ample opportunity to provide persuasive arguments and /or amendment of the claims to overcome the prior art of record this office action is made Non-Final.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application

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claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 10 is rejected on the ground of nonstatutory double patenting over claim 14 of U. S. Patent No. 6,970,250 (See Claim Comparison table below) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Claim 10 of the instant application is anticipated by patent claim 14 in that the claim 14 of the patent contains all the limitations of the instant application. Claim 10 of the instant application therefore is not patentably distinct from the earlier patent claim and as such is unpatentable for obvious-type double patenting (*In re Goodman (CAFC) 29 USPQ2d 2010 (12/3/1993)*).

Claim Comparison Table

Claim No.	US Patent 6,970,259	Claim No.	Application 09/722,508
14	A document forgery protection printing system, comprising: at least one image processor that processes an image of document	10	A document forgery protection printing system, comprising: at least one image processor that processes an image of the document;

	<p>including at least one page;</p> <p>at least one server having a print management system and a policy that determines a forgery protection level for the document, the policy using a plurality of factors including at least contents related to the documents;</p> <p>a plurality of printers, each printer able to print the document and able to apply at least one protection level to the document by printing at least one watermark including copy evidence and tracing information on the document that corresponds to the determined protection level.</p>		<p>at least one server having a print management system and a policy that determines a foraeerv protection renuirements and a forgery protection level for the document;</p> <p>a plurality of printers, each printer able to print the docllment and able to apply at least one protection level to the document by printing at least one watermark on the document that corresponds to the determined protection level.</p>
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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1- 17 are rejected under 35 U.S.C. 102(e) as being anticipated by prior art of record to Stefik et al. (hereinafter “Stefik”).

As per claim 1, Stefik teaches a document forgery protection printing method, comprising (abstract):

processing an image of a document [Fig.5, element 501, see also col. 11, lines 25-30, col. 12, lines 10-15];

determining forgery protection requirements for the document to be printed [Figure 17 and associated text, numeral element 1705 where print server collects watermark information (forgery protection requirements), col. 3, lines 22-55 (encoding print right associated with the work), see also col. 5, lines 47-59, Fig.10 and associated text, print right specifies that a purchaser of the document must pay fees and that document must only be printed on a trusted printer, col. 16-36, i.e. print right specifies that a purchaser of the document must pay fees and that document must only be printed on a trusted printer, col. 5, lines 47-59, see also Fig.10 and associated text] utilizing a print management system and a computerized policy stored on a computer device [Figures 16 and 17 and associated texts, col. 16, lines 61 through col. 18, line 5, a print server and spooler (print management) manage and schedule the printing of the digital work (col. 16, lines 51-57) by enforcing a policy , col. 17, line 14 through col. 18, line 5, i.e. looking up the watermark information in a certificate];

determining a protection level to be applied to the document based on the determined forgery protection requirements [5, numeral element 501, i.e. a print usage right which specifies watermark information, col. 8, lines 40-54, i.e. expressing the rights in a rights language and that

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different watermarking technologies is applied to the same digital work, see also col. 10, col. 19-52Fig];

selecting a printer from a plurality of printers that can print the document [Fig. 5, numeral element 508, see also col. 4, lines 61-64]; and

based on the determined protection level, printing at least one watermark on the document that corresponds to the determined protection level using the selected printer [col. 7, lines 21-44, fig. 3, printer system 301, Fig. 6, elements 612].

As per claims 2, Stefik teaches the method of claim 1, wherein determining the forgery protection requirements includes displaying information about forgery techniques and using the displayed information in determining the forgery protection requirements to be applied to the document [Figure 6 and associated text, elements 607-611, i.e. copy, transfer, play or print, protection requirements representing forgery techniques and a watermark (element 613) embedding the rights)].

As per claim 3, Stefik teaches the method of claim 2, wherein displaying information further includes displaying information about forgery techniques each protection level is able to at least one of detects and deter and information about costs of using each protection level [col. 3, lines 21-55].

As per claim 4, Stefik teaches the method of claim 1, wherein determining the forgery protection requirements includes collecting information about the document and using the collected information in determining forgery protection requirements [Fig. 6 and associated text, elements 601-603 represents information about the document which determines forgery protection requirements disclosed in elements 604-611, see also Fig. 8 and associated text].

As per claim 5, Stefik teaches the method of claim 1, wherein determining the protection level includes identifying at least one of a creator of the document, a person entering a command to print the document, and an image processor that processes the image of the document, and using the at least one identification in determining forgery protection requirements [Fig. 6, elements 602 (work-ID), 603 (Owner) and 604 (Rights-Group) and 606 (Access representing security –level), see also col. 9, lines 14-19].

As per claim 6, Stefik teaches the method of claim 1, wherein determining the protection level includes reviewing contents of the document and using the contents of the document in determining forgery protection requirements [Fig. 8 and associated test, see also col. 12, lines 36-52].

As per claim 7, Stefik teaches the method of claim 1, further comprising querying the plurality of printers to determine the protection level each printer can apply to the document and using one of the printers with a specific combination of protection techniques [Fig. 12 and associate text, see also col. 12, line 63 through col. 13, line 41, i.e. security and capabilities of the printer are checked and that the printer security and capabilities are specified an a certificate containing identification for the printer].

As per claim 8, Stefik teaches the method of claim 1, further comprising setting printing parameters on the selected printer to apply the determined protection level to the document based on the policy [col. 13, lines 20-41].

As per claim 9, Stefik teaches the method of claim 1, wherein determining the protection level includes at least one of assigning and selecting the protection level by at least one of a creator of the document and a person entering a command to print the document and the policy

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[col. 12, lines 9-36, i.e. author or publisher assigns rights to the work using Right Editor (a program with which the document owner specifies terms and conditions of using a digital work), see also col. 17, line 14 through col. 18, line 5, i.e. looking up the watermark information in a certificate].

As per claim 10, Stefik teaches a document forgery protection printing system, comprising [col. 16, line 14-19]:

at least one server [Figure 16, Spooler 1603] having a print management system and a policy [col. 17, line 14 through col. 18, line 5, i.e. looking up the watermark information in a certificate, see also Figure 17 and associated text, element 1705] that determines a forgery protection requirements [Figure 10 and associated text, see col. 12, lines 16-36] and a forgery protection level for the document [Fig. 17, element 1705-1706, col. 17, line 14 through col. 18, line 5];

at least one image processor that processes an image of the document [Fig. 5 and associated text, element 501, see also col. 11, lines 25-30, col. 12, lines 10-15];

a plurality of printers, each printer able to print the document and able to apply at least one protection level to the document by printing at least one watermark on the document that corresponds to the determined protection level [Fig. 5, numeral element 508, col. 4, lines 61-64, see also col. 7, lines 21-44, fig. 3, printer system 301, Fig. 6, elements 612].

As per claim 11, Stefik teaches the document forgery protection printing system of claim 10, further comprising a display device, at least one of the server and one of the at least one image processors driving the display device to display information about forgery techniques and using the displayed information in determining forgery protection requirements for the

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documents [Figure 6 and associated text, elements 607-611, i.e. copy, transfer, play or print, protection requirements representing forgery techniques and a watermark (element 613) embedding the rights)], see also col. 6, lines 18- 45, see also col. 7, lines 21-44].

As per claim 12, Stefik teaches the document forgery protection printing system of claim 11, wherein the displayed information includes information about forgery techniques each protection level is able to at least one of detect and deter and information about costs of using each protection level [col. 3, lines 21-39].

As per claim 13, Stefik teaches the document forgery protection printing system of claim 10, wherein the policy searches content of document and determines the protection level for the document based on information collected from at least one of a creator of the document and a person entering a command to print the document [Fig. 6 and associate text, elements 602 (work-ID), 603 (Owner) and 604 (Rights-Group) and 606 (Access representing security –level), col. 9, lines 14-19, see also Fig. 8 and associated test, see also col. 12, lines 36-52].

As per claim 14, Stefik teaches the document forgery protection printing system of claim 10, wherein the policy searches content of the document determines the protection level based on at least one of a creator of the document, a person entering a command to print the document, and an image processor that processes the image of the document [Fig. 6 and associate text, elements 602 (work-ID), 603 (Owner) and 604 (Rights-Group) and 606 (Access representing security –level), col. 9, lines 14-19, see also Fig. 8 and associated text, see also col. 12, lines 36-52].

As per claim 15, Stefik teaches the document forgery protection printing system of claim 10, wherein the policy determines the protection level based on at least one of a keyword

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and key phrase search from contents of the document [Fig. 8 and associated text, see also col. 12, lines 36-52].

As per claim 16, Stefik teaches the document forgery protection printing system of claim 10, wherein the policy determines the protection level based at least in part on a forgery protection requirements [col. 9, line 65 through col. 10, line 18] and a protection level assigned to the document [col. 12, lines 9-51].

As per claim 17, Stefik teaches the document forgery protection printing system of claim 10, wherein the server sets printing parameters for the selected printer selected to apply the determined protection level to the document based on the policy [Figure 17 and associated text, element 1705, Figure 10 and associated text, see col. 12, lines 16-36, see also col. 13, lines 20-41].

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taghi T. Arani whose telephone number is (571) 272-3787. The examiner can normally be reached on 8:00-5:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Taghi T. Arani, Ph.D.

Examiner

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1/17/2006